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REMARKS

This response is in response to the final Office action (Paper No. 12) dated 15 October 2003.

Claims 3-6 and 20-28 are pending in the application.

Claim 20 has been amended. An amendment adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner. No new matter is added.

I. Regarding Prematureness of the Finality of the Action

The Examiner asserted that Applicant's amendment necessitated the new ground(s) of rejection presented in the office action (Paper No. 12) and, accordingly, the office action was made final.

The Examiner's assertion is improper because the Examiner introduces a new ground rejection that is not necessitated by the applicant's amendment of the claims.

Note that MPEP 706.07(a) recites *inter alia*,

Under present practice, second or any subsequent actions on the merits **shall be final, except, where the examiner introduces a new ground rejection that is neither necessitated by the applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed**

during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ----- . Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings **will not be final if it includes a rejection, on the newly cited art, ...**, of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.”

Here, in the Office action dated June 25, 2003 (Paper No. 10), the Examiner rejected claim 20 under 35 U.S.C. §102(b) as being anticipated by Zogg et al. ‘173. The Examiner asserted there that claim 6 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

At the time the examiner made these statements in the Office action (Paper No. 10), the claims 20 and 6 read as follows:

20. An image forming apparatus, comprising;

a photosensitive drum;

a mass body disposed within said photosensitive drum for adding mass to said photosensitive drum;

wherein an outer circumference of said mass body and an inner circumference of said photosensitive drum along an entire longitudinal length of said photosensitive drum are separated from each other by a gap, and are not in contact with each other, the mass body is made of rubber material.

6. The image forming apparatus of claim 20, wherein the mass body is made of rubber material.

In the subsequent final Office action dated October 15, 2003 (Paper No. 12), the Examiner rejected claim 28 under 35 U.S.C. §103(a) as being unpatentable over Miwa et al. (U.S. Patent No. 5,570,160) in view of Shinohara et al. (JP 11-349737).

Claim 28 reads as follows:

28. An image forming apparatus, comprising;
a photosensitive drum; and
a mass body disposed within said photosensitive drum for adding mass to said photosensitive drum;
wherein an outer circumference of said mass body and an inner circumference of said photosensitive drum along an entire longitudinal length of said photosensitive drum are separate from each other by a gap, and are not in contact with each other, and the mass body is made of rubber material.

Claim 28 is the independent claim including all of the limitations of the claim 20 and the claim 6. Claim 28 has the same limitations which claim 6 would have if rewritten in independent form. Therefore, the rejection of claim 28 on the basis of the newly cited

art should have been made on claim 6 before to make the Office action (Paper No. 12) final. Even if the applicant relied on the examiner's suggestion, the examiner asserted that Applicant's amendment necessitated a new ground of rejection.

Since there is a new ground of rejection introduced by the Examiner but not necessitated by Applicant's amendment, reconsideration of the finality of the action is respectfully requested.

II. Claim Rejections - 35 U.S.C. §112

Claims 20, 3-6 and 27 stand rejected under 35 U.S.C. 112, second paragraph, because there is no antecedent basis for "said main body" in claim 20.

The phrase "said main body" in claim 20 has been corrected to "said mass body."

Accordingly, withdrawal of the rejection is respectfully requested.

III. Claim Rejections - 35 U.S.C. §103

Claim 28 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Miwa et al. '160 in view of Shinohara et al. JP11-349737 ("Shinohara et al. '737").

Shinohara et al. '737 cannot be used for an obviousness rejection because it is nonanalogous art.

The Court of Appeals for the Federal Circuit (CAFC) has developed a two-step for

determining whether particular references are within the appropriate scope of the inventor's art, *i.e.*, whether the references relate to analogous art. In re Deminski, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 23 USPQ2d 1058 (Fed. Cir. 1992) See MPEP 2141.01(a). In applying the two-step test, it must first be determined whether the prior art reference is within the field of the inventor's endeavor. Second, if the reference is not within the inventor's field of endeavor, then it must be determined whether or not the reference is reasonably pertinent to the inventor's particular solution to a problem. A reference that fails both parts of the test cannot properly be used to support an obviousness rejection under 35 U.S.C. 103.

Here, as to the first test, the present invention is directed to an image forming apparatus. On the other hand, Shinohara et al. '737 is directed to a vibration proof member used for automobiles. (See paragraph [0002] on page 2 of Shinohara et al. '737.) Therefore, Shinohara et al. '737 is not within the field of the inventor's endeavor (*i.e.*, image forming apparatus).

The second test is whether Shinohara et al. '737 is reasonably pertinent to the inventor's particular solution to a problem.

MPEP 21410.01(a) states that:

"See, for example, *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) (Applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp

was tightened.

The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous.

The court held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because **it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.** The Commissioner further argued in the brief on appeal that a disengageable catch is a common everyday mechanical concept, however the court held that the Commissioner did not explain why a "catch" of unstated structure is such a concept, and why it would have made the claimed invention obvious." (Emphasis added)

Here, even if Shinohara et al. '737 discloses a vibrating insulator made of rubber for use in automobiles, Shinohara et al. '737 for use in automobiles is not pertinent to the problem in mass body of image forming apparatus because a person of ordinary skill, seeking to solve a problem of image forming apparatus, would not reasonable be expected or motivated to look to a vibration insulator for automobiles.

In view of the decision of *In re Oetiker*, Shinohara et al. '737 is nonanalogous art


and thus cannot be used for the obviousness rejection.

The examiner's attention is further invited to consider that, unlike the examiner's assertion, there is no similarity between the present invention and Figure 1 of Shinohara et al. '737. The examiner regarded the component 2 in Figure 1 of Shinohara et al. '737 as a drum and the component 1 as a mass body. Figure 1 of Shinohara et al. '737 does not show the structure of the drum and mass body. Figure 1 of Shinohara et al. '737 shows a **test piece** for testing movement characteristics, specifically pressure vibration. Accordingly, the metal plate 2 of Shinohara et al. '737 cannot be regarded as a (photosensitive) drum of the present invention and the cylindrical rubber 1 cannot be regarded as the mass body of the present invention. The examiner's reasoning is untenable. (See paragraph 0042-0043 on page 5 of Shinohara et al. '737).

No fee is incurred by this Amendment.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



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